

REMARKS

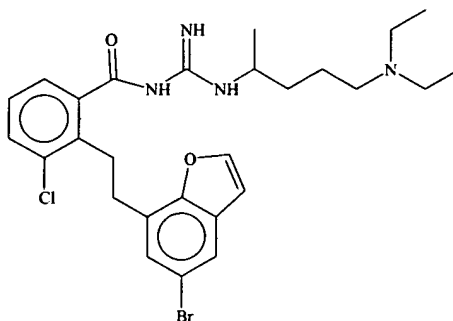
The Restriction Requirement mailed August 26, 2005 refers to the following groups:

Group I: Claims 1-20 and 22; compounds and compositions in various subclasses;

Group II: Claim 21; compounds in various subclasses; and

Group III: Claims 23-32; methods of using the compounds.

In response, Applicants elect Group I for further prosecution, with traverse. The Restriction Requirement also requires election of a particular species if Group I or Group III is elected. Applicants elect the species



which is within the scope of claim 1 and specifically identified as compound 144 in claim 21.

Applicants traverse the restriction requirement on at least the grounds that are stated below. These grounds are somewhat addressed in the Office Action where it states that

A clear statement of the examined invention, defined by those class(es) and subclass(es) will be set forth in the first action on the merits. Note that the restriction requirement will not be made final until such time as applicant is informed of the full scope of compounds along with (if appropriate) the process of using or making said compound under examination. This will be set forth by reference to specific class(es) and subclass(es) examined.

Further, Applicants' representative thanks the Examiner for the courtesy of a telephone call to clarify the restriction requirement. The reasons for traverse that follow are set forth for the record.

First, Guidelines in the Manual of Patent Examining Procedure (MPEP) sets forth that "Examiners must provide reasons and/or examples to support conclusions, . . ." (MPEP 803) The MPEP goes on to state that:

For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02.

(MPEP 803) Although the Office Action asserts that the compounds included within the scope of the claims are “classified in various subclasses of classes,” and provides examples of the classes and subclasses, the Office Action has not sufficiently provided an explanation of the separate classifications. It is thus difficult for the Applicants to make a proper selection of an invention for further prosecution. In particular, the scope of any selection would be unclear.

Second, Applicants submit that they are entitled to examination of a reasonable number of related species. (See MPEP 806.04(a)) Because the restriction requirement is not set out with clarity, Applicants can not be certain that a reasonable number of species will be examined.

Third, the Office Action has stated that “upon election of a single species, the Office will review the claims and disclosure to determine the scope of the individual invention encompassing the elected species.” This is related to the first two points and further indicates that the restriction requirement does not define the allegedly separate and distinct inventions in manner sufficient to define the Groups the examiner is setting for the and what the Applicant is electing.

Finally, the insufficiency of the restriction requirement in its current form is evident in that the compounds of claim 21 are a subset of the compounds of claim 1 and, therefore, do not constitute an independent and distinct invention. For clarity, claim 21 has been amended to depend from claim 1. Applicants respectfully submit that the compounds of claim 21 that fall within the final definition of the finally elected group should be examined with the other compounds of Group I.

Because the final form of the restriction requirement will not be known until a first action on the merits is issued, applicants reserve the right to further traverse any restriction. Applicants also reserve the right to file one or more divisional applications directed toward non-elected subject matter. Applicants also reserve the right to request rejoinder of method claims 23—32 if amended to include all of the limitations of an allowable compound claim.

Election of Substituents

The restriction requirement also states that

If Invention I or III are elected, election of a single species is further required, including an exact definition of each substitution on the base molecule, Formula (I), wherein a single member at each substituent group is selected. For example, in the instant application, the base molecule of Formula (I) of Group I and substituent G, "G is selected from the group consisting of a G1, G2 or G3." Applicant must select a single substituent representing G and in the case where contains substituent groups, the substituents and variable positions for the substituents are required.. This process is repeated for each variable so that a single compound is identified.

Applicants elect the compounds of Group I in which G is G2. Applicants further submit that those compounds of Group I in which G is G2 define a related group that is sufficiently well defined to represent a single genus for further prosecution. Applicants further note that claim 7 and claims dependent therefrom (claims 8-11 and, at least in part, claims 21-32), are compounds in which G is G2.

As for individual and progressively narrow sub-genuses, for completeness, Applicants elect the following progressively narrow substituents

(a) Compounds of Formula I wherein G is G2;

Constituent parts of G2:

- (b) Compounds according to (a) wherein L_2 is a C_{2-6} alkylidene chain optionally substituted by 1-3 R^6 , and wherein the alkylidene chain is optionally interrupted by $-C(R^{11})_2-$, $-C(R^{11})_2C(R^{11})_2-$, $-C(R^{11})=C(R^{11})-$ or $-C\equiv C-$;
- (c) Compounds according to (b) wherein L_2 is a C_{2-6} alkylidene chain interrupted by $-C(R^{11})_2-$;
- (d) Compounds according to (c) wherein L_2 is a C_3 alkylidene chain interrupted by $-C(R^{11})_2-$;
- (e) Compounds according to (d) wherein one R^{11} is H;
- (f) Compounds according to (e) wherein the other R^{11} is CH_3 ;
- (g) Compounds according to (a) wherein R^2 is independently selected from hydrogen and C_{1-8} aliphatic
- (h) Compounds according to (g) wherein R^2 is hydrogen
- (i) Compounds according to (a) wherein R^3 is hydrogen or C_{1-8} aliphatic

- (j) Compounds according to (i) wherein R^3 is hydrogen
- (k) Compounds according to (a) wherein R^4 is hydrogen, C_{1-8} aliphatic, C_{6-10} aryl, heteroaryl, C_{7-12} aralkyl, or heteroaralkyl
- (l) Compounds according to (k) wherein R^4 is hydrogen or C_{1-8} aliphatic,
- (m) Compounds according to (l) wherein R^4 is C_{1-8} aliphatic
- (n) Compounds according to (m) wherein R^4 is ethyl
- (o) Compounds according to (a) wherein R^5 is hydrogen or C_{1-8} aliphatic,
- (p) Compounds according to (o) wherein R^5 is C_{1-8} aliphatic
- (q) Compounds according to (p) wherein R^5 is ethyl

Narrowed Definition of X:

- (r) Compounds according to (a) wherein X is oxygen

Constituent parts of ring A:

- (s) Compounds according to (a) wherein Ring A is a 6-membered aromatic ring having 0-2 ring nitrogen atoms, wherein Q and $C(=X)N(R^1)-G$ are attached at ortho positions on Ring A, and wherein Ring A is optionally substituted by one to three R^7
- (t) Compounds according to (s) wherein Ring A is a 6-membered aromatic ring optionally substituted by one to three R^7
- (u) Compounds according to (t) wherein each R^7 is independently selected from -halo, $-NO_2$, $-CN$
- (v) Compounds according to (u) wherein R^7 is -halo
- (w) Compounds according to (v) wherein R^7 is -chloro
- (x) Compounds according to (w) wherein R^7 is ortho with respect to Q and meta with respect to $C(=X)N(R^1)-G$

Narrowed definition of Q:

- (y) Compounds according to (a) wherein Q is a C_2-C_4 alkylidene chain optionally substituted by one to three R^9
- (z) Compounds according to (y) wherein Q is an unsubstituted C_2-C_4 alkylidene chain
- (aa) Compounds according to (z) wherein Q is $-CH_2CH_2-$

Constituent parts of ring B:

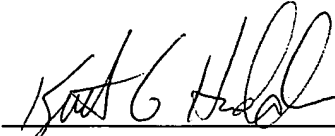
- (bb) Compounds according to (a) wherein Ring B is a 6-membered aromatic ring having 0-2 ring nitrogen atoms, and optionally substituted by one or more R^8 ;
- (cc) Compounds according to (bb) wherein Ring B is a 6-membered aromatic ring having 0 ring nitrogen atoms, wherein Ring B is substituted by one or more R^8
- (dd) Compounds according to (cc) wherein Ring B is substituted by three R^8
- (ee) Compounds according to (dd) wherein one R^8 selected from -halo, $-\text{NO}_2$, and -CN, or a substituted or unsubstituted group selected from $-\text{R}^{12}$, $-\text{OR}^1$, and $-\text{SR}^{12}$
- (ff) Compounds according to (ee) wherein one R^8 is -halo
- (gg) Compounds according to (ff) wherein one R^8 is -bromo
- (hh) Compounds according to (dd) wherein Ring B is substituted by two adjacent R^8 taken together with their intervening atoms to form a 5-6 membered unsaturated or partially unsaturated ring having 0-2 ring heteroatoms selected from nitrogen, oxygen and sulfur;
- (ii) Compounds according to (hh) wherein the two adjacent R^8 taken together with their intervening atoms form a 5 membered partially unsaturated ring having one ring heteroatoms selected from nitrogen, oxygen or sulfur;
- (jj) Compounds according to (ii) wherein the two adjacent R^8 taken together with their intervening atoms form a 5 membered partially unsaturated ring having one oxygen.

CONCLUSION

Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided.

Respectfully submitted,

Dated: November 28, 2005



Keith G. Haddaway, Ph.D.
Registration No. 46,180
VENABLE LLP
P.O. Box 34385
Washington, D.C. 20043-9998
Telephone: (202) 344-4000
Telefax: (202) 344-8300

::ODMA\PCDOCS\DC2DOCS1\701822\1